University Trade-Marks: Registration and Licensing for Commercial Uses

1.0 Policy

Simon Fraser University (the University) has the sole authority to establish and register its Trade-Marks. Through a licensing program, the University will authorize commercial use of its Trade-Marks. All users of its Trade-Marks must meet criteria established by the University to ensure any use does not impair the good name and reputation of the University. Net revenues from commercial use will be used for research and for facilitation of research at the University.

2.0 Purpose

The purpose of this policy is to regulate establishment and use of Simon Fraser University Trade-Marks. Controlled licensing of its Trade-Marks allows the University to promote itself and to earn royalty revenue on products that meet standards of quality and tastefulness. It also protects the good name of the University and limits legal liabilities associated with questionable goods and practices. Centralized negotiation and approval of licensing agreements provides for efficient and orderly administration, ensures that the University obtains a uniform and consistent value for use of its Trade-Marks, and establishes responsibility for monitoring their use.

3.0 Definitions

3.1 Trade-Mark: A word, symbol or design, or combination of these, used to distinguish goods and services offered in the marketplace by different individuals or entities. The University's Trade-Marks include, but are not limited to, its name, crest, and emblem.

3.2 Trade Name: The name under which business is conducted; may be registered under the Trade-Marks Act if it is also used as a Trade-Mark, i.e. to identify wares or services. "SFU" and "Simon Fraser University" are trade names also used as Trade-Marks.

3.3 Registered Mark: A Trade-Mark that has been registered with the Trade-Mark Registrar of the Government of Canada by filing an application and paying a fee. The Trade-Mark must be associated with specific wares or services, either current or proposed. Registration is for 15 years and may be renewed.

3.4 Prohibited mark: A special provision of the Trade-Marks Act prohibits commercial use of University Trade-Marks published by the Trade-Marks Registrar. The Trade-Marks Act prohibits any person from adopting these published Trade-Marks, or any mark that might be mistaken for them, in connection with a business. In contrast to a registered mark, a prohibited mark covers all uses of the mark, not just those specific goods and services for which it was registered.

3.5 Commercial Use: Any manufacture, use, sale, distribution, or advertisement of the University's Trade-Marks in association with any products or services, where the activity is undertaken in anticipation of profit or value, including goodwill.

3.6 Licensed Supplier: The University may approve departments and other units within the University as licensed users of University Trade-Marks. Such units are licensed suppliers of items bearing the Trade-Marks. Licensed Suppliers are approved by Industry Engagement (IE) and are listed in Appendix A.
4.0 Applicability

4.1 Establishment and registration of Trade-Marks: Trade-Marks of Simon Fraser University may be established and registered only through the authority of Simon Fraser University.

4.2 All commercial and non-commercial uses of University Trade-Marks and logos are subject to the approval of the University. Non-commercial use that does not impair the good name and reputation of the University is permitted without explicit approval.

4.3 All commercial uses of University Trade-Marks and logos must be covered by a royalty-bearing licensing agreement.

4.4 Exclusions/exemptions: The only exemptions to the requirement for a royalty-bearing agreement are the following uses of Trade-Marks to identify affiliation with the University:

   a. University Trade-Marks used to identify its own property;
   b. University advertising and promotional materials;
   c. University team uniforms worn by team members;
   d. University stationery used by university personnel for university business;
   e. University Trade-Marks used non-commercially by individuals and organizations affiliated with the University (e.g. employees, students and employee and student groups) to indicate their affiliation with the University.

4.5 Product endorsement: Employees of the University and students of the University who choose to endorse products must make it clear that they do so only as individuals and not on behalf of the University. They may not make use of University Trade-Marks, other than to indicate their place of employment or study.

5.0 Statement of Responsibilities

5.1 The Vice-President, Research is responsible for controlling establishment, registration and use of University Trade-Marks. This authority may be delegated to IE.

5.2 The Vice President, Research must approve of all new Trade-Marks formally registered or published on behalf of the University.

5.3 Use of Trade-Marks by members of the University community on products for sale requires a royalty-bearing license from the University.

5.4 The Vice President, Research is responsible for supervision of non-commercial use of Trade-Marks. This authority may be delegated to IE.

5.5 The Vice President, Research is responsible for the designation of Licensed Suppliers; see section 3.6 above).

5.6 IE is responsible for negotiating and administering all royalty-bearing Trade-Mark Licensing Agreements, including any agreements that exchange goods or promotional activities for the use of the Trade-Mark.

5.7 Signing authority for all license agreements governing commercial use of any the University's Trade-Marks is vested with the Vice-President, Research. This authority may be delegated.

5.8 A University Trade-Marks Licensing Committee will oversee policy implementation, and advise the Vice-President, Research whenever contentious issues arise. The Committee will be composed of representatives from IE, the Alumni Relations Office, the University Bookstore, the Department of Campus Community Services, the Department of Financial Services and other persons appointed from time-to-time by the Vice President, Research. The Committee will be chaired by the representative from IE and will meet at the call of the Chair.
6.0 Procedures

6.1 Prospective applicants for commercial use of the Trade-Marks, from both inside and outside the University, are encouraged to consider using licensed suppliers prior to applying to IE for the right to use the Trade-Marks. Members of the University community are advised to contact licensed suppliers before applying directly for the right to use a Trade-Mark commercially.

6.2 All applications for commercial use of any of the University's Trade-Marks must be submitted in the prescribed format attached hereto as Appendix B and proceed through IE which is responsible for the negotiation and administration of licensing agreements. Any University department, faculty or staff member receiving inquiries regarding commercial use of the University's Trade-Marks must refer such inquiries to IE.

6.3 For commercial use, IE will utilize a standard licensing agreement attached hereto as Appendix C which will include the requirement for the licensee to indemnify the University against any damages or expenses arising from use of a defective product which bears any of the University's Trade-Marks. The standard agreement also will include provision for non-exclusivity and for quality assessment by the University of merchandise covered by the agreement.

6.4 IE will negotiate an agreement with the prospective licensee and produce a draft contract for review by the parties.

6.5 The University's original copy of executed Trade-Mark licenses will be retained by IE for administrative purposes.

6.6 IE will be available to assist licensed users of University Trade-Marks in the technical aspects of the reproduction of the Trade-Marks, including for example provision of colour separations and digital representations of the of the Trade-Marks.

6.7 Enforcement and Control - Commercial Use: If an unlicensed company uses a Trade-Mark without authorization, IE will issue a standard letter to the company's president requesting entry into a licensing agreement within 10 business days of being informed of the unlicensed use. If the company does not respond, IE will telephone the company on the 11th day to determine why. If the company fails to commence negotiations, the University will request its solicitors to commence cease and desist action, including formal notification that an injunction is being sought. The injunction will then be obtained and served; if the company continues to use the unlicensed Trade-Marks, the solicitors will seek court action for remedies.

6.8 Enforcement and Control - Non-Commercial Use: If an individual or group uses a Trade-Mark non-commercially in a manner that may impair the good name and reputation of the University, the Vice President, Research will require the user to cease and desist.

7.0 Fees, Royalty Rate and Terms

7.1 All requests for commercial use of the University's Trade-Marks must be accompanied by an application fee, which is non-refundable.

7.2 An initial license fee will be charged on all approved and executed licenses for commercial uses. This fee is non-refundable for any reason and is not an advance payment of royalties.

7.3 Royalty will be charged at a percentage rate of licensee's selling price. Exceptions to charging at the manufacturer level may be negotiated.

7.4 Fees and rates referred to above are listed in Appendix A and will be established under the authority of the Vice President, Research and may be changed by the Vice-President, Research from time-to-time in consultation with the University Trade-Marks Licensing Committee; such changes will not affect existing agreements.

7.5 Royalty reports and payments will be submitted two times a year, along with quality control samples. The dates are July 15 for the period January-June and January 15 for the period July-December.
7.6 Non-exclusivity: Any license granted to use a Trade-Mark of the University will be non-exclusive. In other words, the University will not be prevented from licensing its Trade-Marks to other users.

8.0 Distribution of Royalty Revenue

8.1 Revenues, net of direct costs (e.g. IE administration, legal fees, auditing fees, related travel by University staff, courses, conferences, membership fees in ACLA, etc.), will be held in an account under the authority of the Vice President, Research. They will be used for research and for the facilitation of research at the University.

9.0 Dispute Resolution

9.1 Disputes over the application of this Policy may be resolved through informal mechanisms and parties to a dispute are advised to consider these prior to commencement of formal processes.

9.2 If informal resolution is not achieved: Disputes involving employees of the University will be resolved through reference to the appropriate collective agreement. Disputes involving students will be resolved through reference to the appropriate appeal mechanism approved by Senate. Disputes involving other persons will be settled by reference to the B.C. Arbitration Act.

10.0 Interpretation

10.1 Questions of interpretation or application of this Policy or its Procedures shall be referred to the President, whose decision shall be final.

APPENDIX A

As of June 26, 1997:

The Licensed suppliers of the University Trade-Marks are:

- The University Bookstore
- SFU Alumni Association
- SFU Athletics and Recreation

The application fee for the use of the University's Trade-Marks is $25.00.

Royalty will be charged at a rate of 8% of licensee's selling price.

An initial license fee of $100.00 will be charged on all approved and executed licenses.

APPENDIX B

Trade-Mark License Application Form

(Please contact University/Industry Liaison Office to obtain a copy of this form)

Appendix C

Standard Licensing Agreement

(Please contact the University/Industry Liaison Office to obtain a copy of this Agreement)